

REMARKS

Claims 1, 2, 4-7, 10-17 and 20-23 are pending in the application.

Claims 1, 2, 4-7, 10-17 and 20-23 were rejected.

Claims 1, 13 and 21 have been amended.

Previously cancelled claims 9, 19 and 25 have been reinstated

I. 35 U.S.C. §103 Claim Rejections

In the Office Action, all pending claims were rejected under 35 USC §103(a) as being unpatentable over various combinations of Fatehi *et al.* (U.S. Patent No. 6,192,172) (hereafter designated Fatehi 172) or Fatehi *et al.* (U.S. Patent No. 5,959,767) (hereafter designated Fatehi 767) in view of Frigo *et al.* (U.S. Patent No. 5,742,414), Egnell *et al.* (U.S. Patent No. 6,590,681) and Pimpinella (U.S. Patent No. 6,396,573). Applicant respectfully traverses these rejections and requests reconsideration by the Examiner.

The invention is directed to an improved approach for distributing signals in optical distribution networks. As Applicants describe in the Specification, optical distribution networks of the prior art are static in nature. That is, in order to change services to a customer or customer group, a physical change in the network configuration or equipment is required. Such a limitation restricts prior-art network reconfigurations to long-term changes, and precludes reconfigurations addressed to short-term demand changes.

To address that limitation of the prior art, the invention provides a dynamically reconfigurable distribution arrangement for optical networks. In particular, the invention provides a cooperative combination of one or more optical cross-connect devices and one or more optical multiplexer units that can be dynamically reconfigured to change the distribution of signals for users served by the optical distribution network in accordance with real-time

changes in demand among such users. The dynamic reconfigurability of signal distribution by the invention is facilitated by respective coupling of selected groups of output ports of the cross-connect devices to ones of the optical multiplexer units.

While one or more of the references cited in support of the §103 rejection may arguably teach one or more of the individual elements of Applicants novel optical distribution arrangement (*e.g.*, an optical cross-connect), none or those references, either alone or in combination with others, can reasonably be construed to show or suggest the unique arrangement taught by Applicants for enabling a dynamic reconfigurability of signals among channels in an optical distribution system. Indeed, it is clear that the systems and methods taught by those references are, at best, limited to the static case described by Applicants as characterizing the prior art.

Applicants respectfully submit that the position of the Office Action – the invention here is shown or suggested by a combination of two or more of the cited references -- represents the prohibited use of the “hindsight” provided by the Applicants’ disclosure as a basis for interpreting the teaching of the prior art. (See *In re Rouffet* (149 F.3d 1350, 1357 (1998)): “use [by the Examiner of] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... would be an illogical and inappropriate process by which to determine patentability”).

Moreover, while Applicants believe that the cited references fail even to provide a teaching that could lead one skilled in the art to the invention here, the rejection is also devoid of another critical factor. As a corollary to the prohibition on “hindsight” analysis, the courts have made clear that a §103 obviousness rejection must include a showing of a motivation in an applied reference to use the teaching of that reference (or a combination of references) in a

manner to replicate the claimed invention. The Federal Circuit's *Rouffet* decision (*id*), is instructive in this regard.

The court stated:

Virtually all inventions are combinations of old elements [*citations omitted*]. Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability.

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Simply put, there is no teaching in any of the cited references that could be read to suggest a combination of elements/functions arranged as taught by the inventors to provide a dynamic reconfigurability of signals provided in distribution channels of an optical distribution system. Accordingly, Applicants respectfully submit one skilled in the art would have found no motivation for combining those references in the manner suggested by the Office Action, and thus that the §103 rejection must fail.

Applicants believe it clear that their invention is patentably distinct from the teaching of any one or combination of the cited references. However, Applicants have concluded that their independent claims may not clearly reflect the distinctions discussed herein, and have accordingly amended each of their independent claims to further characterize the operation of the dynamic signal reconfiguration arrangement of the invention. As so amended, Applicants submit that their claims are clearly patentably distinct from the art of record herein.

Finally, it is noted that, in response to an indication in a prior office action that the limitations of dependent claims 9, 19 and 25 would distinguish over the then-cited art of record, Applicants amended each of their independent claims to incorporate those limitations. Inasmuch as that prior indication of allowability for those dependent claims limitations has now been withdrawn, based on newly cited art, Applicants have further amended their independent claims to remove those limitations, and to reinstate the corresponding, previously abandoned dependent claims.

II. Conclusion

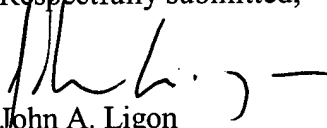
Having fully addressed the Examiner's rejections herein, it is believed that, in view of the preceding amendments and remarks, this application now stands in condition for allowance.

Such allowance is respectfully requested.

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Please charge any fees due in respect to this amendment to Deposit Account No. 50-1944.

Respectfully submitted,


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I hereby certify that this Response to Office Action is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on September 6, 2005.

By:


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